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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,789	08/28/2003	Marc D. Belcastro	021238-597	5581

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EXAMINER

DESAI, HEMANT

ART UNIT PAPER NUMBER

3721

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/649,789

Applicant(s)

BELCASTRO ET AL.

Examiner

Hemant M. Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 4-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/28/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 4-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/8/2004.
2. Applicant's election with traverse of Group II, claims 1-3 and 22-24 in the reply filed on 9/8/2004 is acknowledged. The traversal is on the ground(s) that if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. This is not found persuasive because the inventions are related as combination and subcombination. They are deemed distinct one from the other if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination claimed in Group I, claims 13-18, does not require a control device that controls the angular rotation of the supply spindle and the take-up spindle and feeding the flexible web of paper from a supply spindle of the paper of the subcombination as claimed in Group II, claims 1-3, 22-24. The subcombination has separate utility such as perforating a flexible web of paper.

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Furthermore, since the groups are classified in different class/subclass, it is deemed that there is burden on the Examiner of no restriction was required.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langhans (4378480) in view of Lizotte et al. (6653593).

Langhans discloses a supply of the flexible web (20, fig. 1), supply and take-up spindles are inherent, a laser beam generator (8, fig. 1), at least one multi-faceted mirror (12, fig. 1) positioned in the path of a laser beam emitted from the laser beam generator, the multi-faceted mirror being rotated (see col. 2, lines 24-25) therefore a drive unit to rotate the multi-faceted mirror is inherent, and the rotating multi-faceted mirror dividing the laser beam into a plurality of output beams that are scanned across additional downstream optics (14, 16, 18, fig. 1) and focused to burn a plurality of holes (see fig. 1) in the flexible web.

Langhans, as mentioned above, discloses all the claimed limitations, except for a control device that controls the angular rotations of the supply spindle and the take-up spindle and controls the drive unit to rotate the multi-faceted mirror, and controls power supplied to the laser beam generator in

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response to sensor inputs and control output. However, Lizotte et al. teach the control system (see fig. 11) to control the supply spindle and the take-up spindle and controls the drive unit to rotate the mirror (12, 16, figs. 1-2), and controls power supplied to the laser beam generator in response to sensor inputs and control output (see col. 11, lines 5-67; col. 12, lines 1-6) to facilitate controlling operation of those components. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the control device to control the angular rotations of the supply spindle and the take-up spindle, the drive unit to rotate the multi-faceted mirror, and power supplied to the laser beam generator in response to sensor inputs and control output as taught by Lizotte et al. in the system of Langhans to facilitate controlling operation of the various component.

Regarding claims 2 and 3, Lizotte et al. teach the controller, computer and software (120, 124, 68, fig. 11), therefore it is inherent that the controller is digital motion controller and a programmable logic controller providing an interface for receiving signals from an operator and from other machine controls.

Regarding claim 22, Langhans, as mentioned above, discloses all the limitations of method claim 22.

Regarding claim 23, Langhans discloses that the holes are burned in cigarette tipping paper (see col. 2, lines 5-10).

Regarding claim 24, Langhans discloses that the holes are burned in the flexible web of paper. Langhans does not disclose expressly the range of numbers of holes burned per inch of the flexible web. It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to burn the numbers of holes claimed per inch of the flexible web, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M. Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 7:00 AM-5:30 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Hemant M. Desai*

Hemant M Desai  
Examiner  
Art Unit 3721

HMD